



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,752	02/02/2001	Takashi Yamaguchi	0649-0772P	6901

2292 7590 09/06/2002

BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER

YOON, TAE H

ART UNIT	PAPER NUMBER
----------	--------------

1714

9

DATE MAILED: 09/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
--------------------	-------------	-----------------------	---------------------

EXAMINER
----------

ART UNIT	PAPER NUMBER
----------	--------------

DATE MAILED:

9

Below is a communication from the EXAMINER in charge of this application  
COMMISSIONER OF PATENTS AND TRADEMARKS

**ADVISORY ACTION**

**THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.**

Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 707.07(f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (see NOTE below);
- (b) ☐ they raise the issue of new matter. (see NOTE below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE:

4. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_
5. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attachments
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
- Claim(s) allowed: \_\_\_\_\_
- Claim(s) objected to: \_\_\_\_\_
- Claim(s) rejected: 1-8
- Claim(s) withdrawn from consideration: \_\_\_\_\_
9. ☐ The proposed drawing correction filed on \_\_\_\_\_ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
11. ☐ Other: \_\_\_\_\_

*Tae H. Yoon*

TAE H. YOON  
PRIMARY EXAMINER

Art Unit: 1714

### ATTACHMENT TO ADVISORY ACTION

The recitation of the new limitation, 40 mol% (from 50 mol%) found in the specification into the claim in order to avoid the comparative example 1 having applicant's claimed upper limit, 49.5 mol% of the adduct, which exhibits inferior properties as seen in Table 1, page 17 after the final rejection raises new issues that would require a further search and at least further consideration. Thus, the entry of the amendment is denied.

Applicant asserts the New Matter rejection was improper since the specification mentions "ethylenically unsaturated group-containing monomers" and that these ethylenically unsaturated group-containing monomers suffer the drawback of smell and safety, and thus one skilled in the art readily understand elimination of ethylenically unsaturated group-containing monomers by only a small amount of inference. But the examiner disagrees since the claims do not eliminate ethylenically unsaturated group-containing monomers since they recite "wherein the composition is substantially free of ethylenically unsaturated group-containing monomers" which includes said ethylenically unsaturated group-containing monomers contrary to applicant's assertion.

Note that the examiner didn't reject the word "substantially" being vague and indefinite, and thus there is nothing to withdraw the rejection contrary to applicant's assertion.

With respect to *In re Johnson*, again, the instant claims do not eliminate ethylenically unsaturated group-containing monomers as the reason given above contrary to applicant's assertion.

Art Unit: 1714

With respect to Hefner et al, the instant claims recite "wherein the composition is **substantially free** of ethylenically unsaturated group-containing monomers" which **permits the presence** of said ethylenically unsaturated group-containing monomers contrary to applicant's assertion.

With respect to JP, the instant claims recite "wherein the composition is **substantially free** of ethylenically unsaturated group-containing monomers" which **permits the presence** of said ethylenically unsaturated group-containing monomers contrary to applicant's assertion.

First, the art of matted materials of the instant invention stated by applicant is not claimed, and the recited preamble "a molding composition" encompasses any molding. Second, there is no limitation regarding a molecular weight of the resin or the viscosity of the composition, and thus applicant's assertion lacks any probative value.

Note that Hefner, Jr. et al teach the instant bis(hydroxypropyl)bisphenol A, and JP is cited to show the amount (mol%) of an alkylene oxide adduct in an unsaturated polyester and polyesteramide regardless of a hydrogenation. Besides, Hefner, Jr. et al teach employing said adduct, bis(hydroxypropyl)bisphenol A and a mixture of polyols at col. 3, lines 36-46, and thus the utilization of the instant mol% is a *prima facie* obviousness even without JP.

Applicant asserts unexpected results, the invention does not have the smell and safety problems, however, applicant teaches that even comparative examples have no irritating smell at page 15, line 21. Thus, such assertion has no probative value. Besides, the comparative example 1 having applicant's claimed upper limit, 49.5 mol% of the adduct, exhibits inferior properties as

Art Unit: 1714

seen in Table 1, page 17. However, said comparative example 1 actually falls within the claimed invention, 50 mol%.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

THY/September 5, 2002



TAE H. YOON  
PRIMARY EXAMINER